

REMARKS

Reconsideration and allowance in view of the foregoing amendments and the following remarks are respectfully requested.

Upon entry of this Amendment, claims 1-58 remain pending in the present application. Claims 20-58 have been withdrawn from consideration.

This Supplemental Amendment is filed responsive to the Notice of Non-Compliant Amendment dated January 13, 2004. This Supplemental Amendment is identical to the Amendment dated December 18, 2003 except that it includes the full text of withdrawn claims 20-58, what were indicated as missing from the December 18, 2003 in the Notice of Non-Compliant Amendment. Thus, the present Supplemental Amendment corrects the non-compliance issue. Accordingly, applicant respectfully requests that this Supplemental Amendment be entered and considered on its merits.

A. Restriction Requirement

The Examiner indicates that the present application contains four distinct inventions and listed the claims for each group on page 2 of the Office Action. Applicant hereby affirms the election of the invention of Group I, claims 1-19, for prosecution in the present application. Thus, claims 20-58 have been withdrawn from consideration. Applicant reserves the right to file Divisional applications directed to the inventions defined in claims 20-58.

B. Information Disclosure Statement

An Information Disclosure Statement (IDS) was submitted by the applicant on October 4, 2001. According to the Examiner, a copy of the IDS is missing from the file. As requested by the Examiner, a copy of this IDS is enclosed. Also enclosed is a copy of the PTO-1449 forms accompanying this IDS.

C. Interpretation of the Claims Under 35 U.S.C. § 112, ¶6

On page 4 of the June 18, 2003 Office Action the Examiner indicates that the claims are *not* being interpreted under 35 U.S.C. § 112, ¶6, even though the claims use the phrase “means for”. The Examiner suggests that if the claims are to be interpreted under 35 U.S.C. § 112, ¶6, the applicant should expressly state this desire on the record.

Applicant respectfully submits that requiring the applicant to expressly state when a claim limitation is to be interpreted under 35 U.S.C. § 112, ¶6 is imposing a burden on the applicant that is not required under current US patent law. M.P.E.P. § 2181 sets forth the criteria by which a claim limitation is to be analyzed to determine whether it is a 35 U.S.C. § 112, ¶6 limitation. Short of there being some ambiguity as to whether a limitation is intended to be a means-plus-function limitation, there is no need or requirement that the applicant expressly state up front whether or not a limitation is intended to invoke an interpretation under 35 U.S.C. § 112, ¶6.

Be that as it may, applicant states, for the record, that any claim limitation using the phrase “means for” is intended to invoke an interpretation under 35 U.S.C. § 112, ¶6, per the claim construction guidelines set forth in M.P.E.P. § 2181. Thus, for example, the limitations in claim 1 that begin, “means for selectively establishing...” are intended to be interpreted as mean-plus-function limitations, while the limitation that begins, “an information management center...” and “a hand-held patient appliance...” are not. Applicant submits that the Examiner, in construing the claims as not being mean-plus-function limitations, has apparently ignored the guidelines set forth in M.P.E.P. § 2181.

D. Lexicography

The Examiner indicates that if the applicant wishes to use lexicography such that a claim limitation has a meaning other than its ordinary and accustom meaning, the claim limitation at issue should be expressly indicated, and the specification or prosecution history showing that meaning should be identified, otherwise any interpretation other than the ordinary

meaning will be forfeited. Applicant respectfully submits that the Examiner is again imposing a burden on the applicant that is not required under current US patent law.

The case-law cited by the Examiner states the conditions under which a patentee may attempt to give a limitation a meaning other than its ordinary meaning, i.e., to be his or her own lexicographer. However, that case-law does not require an applicant to expressly state during the prosecution of an application which, if any, claim terms are to have a meaning other than its ordinary meaning. Moreover, the Examiner's indication, that the applicant will forfeit the ability to be his or her own lexicographer unless the applicant states in response to the June 18, 2003 Office Action the meaning of any term not intended to have an ordinary meaning, is preposterous.

Claim interpretation is an issue of special importance typically after a patent has been granted, when an accused infringing device is being compared to the claims in the issued patent. To require an applicant to expressly state, during the prosecution of the patent application, whether a limitation or term is to have a meaning other than its ordinary and accustomed meaning, and to indicate what that meaning is, requires the applicant to predict the future. Under the Examiner's claim interpretation conditions, an applicant must predict what interpretation a future infringer may try to impose on a term, and to nullify that interpretation by expressly stating here and now what the correct interpretation should have been. This simply cannot be done.

Applicant recognizes that terms used in the claims are presumed to have their ordinary meaning. Applicant further notes that the specification, claims, figures, prosecution history, and any other intrinsic evidence can be used to interpret a claim to understand that meaning. Therefore, no attempt is made herein to analyze whether a term used in the claims is to have a meaning beyond that which is ordinary. Despite the Examiner's warning to the contrary, applicant reserves the right to interpret the terms used in the claims, both during and after prosecution, consistent with established case-law. Applicant further recognizes that the Examiner cannot remove the applicant's right to rely on established case-law concerning claim interpretation, including whether or not a claim term is to have its ordinary meaning or some

other meaning, simply because the applicant has not explicitly indicated the claim term is to have a meaning other than an ordinary meaning.

E. Amendments to the Specification

The specification has been amended above to change the title of the invention. Applicant submits that the new title more closely describes the invention defined in the pending, non-withdrawn claims. Accordingly, applicant respectfully requests that the above amendment to the title be approved.

F. Rejection of the Claims based on the Cited References

Claims 1-6, 8-15, and 17-19 stand rejected under 35 U.S.C. § 102 as being anticipated by published PCT Appln. Pub. No. WO 99/13766 to Vrzalik et al. (“the ‘766 reference”). In addition, claims 7 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over the ‘766 reference in view of U.S. Patent No. 6,018,713 to Coli et al. (“the ‘713 patent”). Finally, claims 8 and 17 also stand rejected under 35 U.S.C. § 103 as being unpatentable over the ‘766 reference in view of U.S. Patent No. 6,564,207 to Abdoh (“the ‘207 patent”). Applicant respectfully traverses this rejection for the reasons presented below.

Independent claims 1 and 11 recite a medical information management system and method that includes having a patient use a hand-held patient appliance that has an input/output device, a processor, and a memory. The patient uses the hand-held appliance in an interactive fashion based on patient tailored presentation that is generated by the processor based on data stored in the memory. The hand-held patient appliance communicates with an information management center via a first communication link.

A healthcare professional associated with that patient also interacts with the information management center via a healthcare professional terminal. However, the healthcare professional terminal provides a healthcare professional tailored presentation that is different from the patient tailored presentation. In addition, a third party (such as a family member) interacts with the information management center via a third party terminal. The third party terminal provides the user with a third-party tailored presentation that is different from the patient tailored presentation and different from the healthcare professional tailored presentation.

Applicant submits that the cited references do not teach or suggest a medical information management system and method having these features.

The '766 reference teaches using a bed as a patient appliance, where the input/output device, processor, and memory are all connected to the bed. The claimed invention, on the other hand, defines the patient appliance as being a hand-held device. Clearly, a bed is not something that corresponds to a hand-held device. Furthermore, it would not be obvious to modify the teachings of the '766 reference to change the bed to hand-held device because eliminating the bed would render it inoperable for its intended purpose as a critical care system. If the proposed combination of references makes a prior art reference inoperable for its intended purpose, the resulting inoperable prior art reference may be considered to teach away from the proposed combination, i.e., not teach the combination, thereby supporting a showing of nonobviousness. *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). It is well settled that obviousness cannot be established if the proposed modification to the reference renders it useless for its intended purpose. *Ex parte Westphalen*, 159 U.S.P.Q. 507, 508 (Bd. App. 1967); *see also*, *Ex parte Hartmann*, 186 U.S.P.Q. 366, 367 (Bd. App. 1974).

The Examiner correctly notes that the '766 reference teaches providing different levels of information to the various users of the system. See, page 18, lines 11-13, of the '766 reference. However, the '766 reference does not teach or suggest that the different levels of information be presented in a different manner for each type of user. As noted above, the present invention provides a patient tailored presentation, a healthcare professional tailored presentation, and a third-party tailored presentation each of which is different from the others so that each user is presented with information, both in terms of content and presentation format, that particularly suits that user. That is, the term "presentation" as used in the claims, means both the content and the format that the information is provided to the user. The '766 reference does not teach or suggest, for example, that the format for the information changes based on which type of user receives the information. At best, the '766 reference teaches that the content of the information changes. Furthermore, the other cited references do not teach or suggest modifying the format by which information is presented based on the type of user to whom the information is provided.

For the reasons presented above, applicant respectfully submits that independent claims 1 and 11 are not anticipated or rendered obvious by the cited references. In addition, claims 2-10 and 12-19 are also not anticipated or rendered obvious due to their dependency from independent claims 1 or 11, as well as on their own merits. For example, claim 3 recites limitations not found in the cited references, nor has the Examiner indicated where these features of claim 3 are taught or suggested. Accordingly, applicant respectfully request that the above rejection of claims 1-19 be withdrawn.

All objections and rejections have been addressed. It is respectfully submitted that the present application is in condition for allowance and a Notice to the effect is earnestly solicited.

Respectfully submitted,

By Michael W. Haas

Michael W. Haas

Reg. No.: 35,174

Tel. No.: (724) 387-5026

Fax No.: (724) 387-5021

RESPIRONICS, INC.
1010 Murry Ridge Lane
Murrysville, PA 15668-8525

Attached: 1) Copy of October 4, 2001 Information Disclosure Statement and PTO-1449 Forms.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of

SUN et al. : Group Art Unit: 2161

Appln. No.: 09/814,143 : Examiner: Unknown

Filed: September 21, 2001 : Conf. No.: 2483

For: MEDICAL INFORMATION
MANAGEMENT SYSTEM AND
PATIENT INTERFACE APPLIANCE

* * * * *

October 4, 2001

INFORMATION DISCLOSURE STATEMENT

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

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Sir:

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Attached is a Form PTO-1449 listing the enclosed documents.

This Information Disclosure Statement is being filed within 3 months of the filing date of this application.

Should a first action on the merits have been issued on the same day or before this Information Disclosure Statement is filed, please accept this Information Disclosure Statement under Rule 97(c) and charge the requisite Rule 17(p) fee to our Deposit Account No. 50-0558 and proceed to consider this Information Disclosure Statement.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on October 4, 2001 with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231.


Michael W. Haas, Reg. No. 35,174

SUN et al. -- Appln. No.: 09/814,143

Consideration of the foregoing and enclosures plus the return of a copy of the herewith Form PTO-1449 with the Examiner's initials in the left column per MPEP 609 along with an early action on the merits of this application are earnestly solicited.

Respectfully submitted,

By Michael W. Haas
Michael W. Haas
Reg. No.: 35,174
Tel. No.: (412) 473-5026
Fax No.: (412) 473-5021

RESPIRONICS INC.
1501 Ardmore Boulevard
Pittsburgh, PA 15221-4401
1-800-638-8208



PTO/RS008 Form (RESPIRONICS Version) INFORMATION DISCLOSURE STATEMENT BY APPLICANT				Application No.	09/814,143
				Filing Date	September 21, 2001
				Inventor	SUN et al.
				Confirmation No.	2483
				Group Art Unit	2161
Date	October 4, 2001			Examiner:	Unknown
Sheet	1	of	4	Attorney Docket No:	00-02

U.S. PATENT DOCUMENTS						
Examiner Initials	Cite No.	U.S. Patent Document		Name of Patentee	Publication Date MM-DD-YYYY	Relevant Pages, Columns, Lines
		Number	Kind Code			
	A	3,726,270		Griffis et al.	04/10/1973	
	B	4,004,577		Sarnoff	01/25/1977	
	C	4,173,971		Karz	11/13/1979	
	D	4,531,527		Reinhold, Jr. et al.	07/30/1985	
	E	4,952,928		Carroll et al.	08/28/1990	
	F	5,036,852		Leishman	08/06/1991	
	G	5,301,105		Cummings Jr.	04/05/1994	
	H	5,307,263		Brown	04/26/1994	
	I	5,416,695		Stutman et al.	05/16/1995	
	J	5,522,396		Langer et al.	06/04/1996	
	K	5,544,649		David et al.	08/13/1996	
	L	5,549,117		Tacklind et al.	08/27/1996	
	M	5,601,435		Quy	02/11/1997	
	N	5,633,910		Cohen	05/27/1997	
	O	5,660,176		Iliff	08/26/1997	
	P	5,678,571		Brown	10/21/1997	

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FOREIGN PATENT DOCUMENTS								
Examiner Initials	Cite No.	Foreign Patent Document			Patentee or Applicant	Publication Date MM-DD-YYY	Relevant Pages, Columns, Lines	T
		Office	Number	Kind Code				
	Q	WO	00/70889			11/23/2000		
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EXAMINER: Initial if citation is considered, whether or not citation is in conformance with MPEP § 609. Draw a line through the citation if not in conformance and not considered. Per MPEP § 609, include a copy of this form with the next communication to the Applicant.



PTO/SB 08 Form (RESPIRONICS Version)				Application No.	09/814,143
INFORMATION DISCLOSURE STATEMENT BY APPLICANT				Filing Date	September 21, 2001
				Inventor	SUN et al.
				Confirmation No.	2483
				Group Art Unit	2161
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Sheet	2	of	4	Attorney Docket No:	00-02

U.S. PATENT DOCUMENTS						
Examiner Initials	Cite No.	U.S. Patent Document		Name of Patentee	Publication Date MM-DD-YYYY	Relevant Pages, Columns, Lines
		Number	Kind Code			
	A	5,704,364		Saltzstein et al.	01/06/1998	
	B	5,704,366		Tacklind et al.	01/06/1998	
	C	5,730,143		Schwarzberg	05/24/1998	
	D	5,772,586		Heinonen et al.	06/30/1998	
	E	5,785,650		Akasaka et al.	07/28/1998	
	F	5,827,180		Goodman	10/27/1998	
	G	5,828,943		Brown	10/27/1998	
	H	5,832,448		Brown	11/03/1998	
	I	5,879,163		Brown et al.	03/09/1999	
	J	5,897,493		Brown	04/27/1999	
	K	5,980,447		Trudeau	11/09/1999	
	L	5,991,729		Barry et al.	11/23/1999	
	M	5,997,476		Brown	12/07/1999	
	N	6,014,626		Cohen	01/11/2000	
	O	6,022,315		Iliff	02/08/2000	
	P	6,050,940		Braun et al.	04/18/2000	

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FOREIGN PATENT DOCUMENTS								
Examiner Initials	Cite No.	Foreign Patent Document			Patentee or Applicant	Publication Date MM-DD-YYY	Relevant Pages, Columns, Lines	T
		Office	Number	Kind Code				
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			Inventor	SUN et al.	
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Sheet	3	of	4	Attorney Docket No:	00-02

U.S. PATENT DOCUMENTS						
Examiner Initials	Cite No.	U.S. Patent Document		Name of Patentee	Publication Date MM-DD-YYYY	Relevant Pages, Columns, Lines
		Number	Kind Code			
	A	6,083,172		Baker, Jr. et al.	07/04/2000	
	B	6,093,146		Filangeri	07/25/2000	
	C	6,110,108		Shimura et al.	08/29/2000	
	D	6,113,540		Iliff	09/05/2000	
	E	6,135,949		Russo et al	10/24/2000	
	F	6,168,563		Brown	02/02/2001	
	G	6,248,065		Brown	07/19/2001	
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Sheet	4	of	4	Attorney Docket No:	00-02

OTHER PRIOR ART -- NON PATENT LITERATURE DOCUMENTS			
Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T
	Y	"The Health Hero Network Online Service", www.healthhero.com, 1999	
	Z	"The Health Buddy Appliance", www.healthhero.com, 1999	
	AA	AMERICAN TELEMEDICINE ASSOCIATION, "Telemedicine: A Brief Overview", Developed for the Congressional Telehealth Briefing June 23, 1999, Washington, D.C., USA	
	BB	"Developments in Diagnosis and Monitoring", The BBI Newsletter, December 1999, 262-264	
	CC	Associated Press, "Internet Device Serves as Lifeline", Jan. 13, 2000	
	DD	MILLER, "'Electronic House Call' System Gaining Notice", Feb. 19, 2000	
	EE		
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